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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,005	08/21/2001	Hiroshi Sasaki	DP-800 US	6089
7590	07/21/2004		EXAMINER	
McGinn & Gibb, PLLC. Suite 200 8321 Old Courthouse Road Vienna, VA 22182-3817			RUHL, DENNIS WILLIAM	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/933,005	SASAKI, HIROSHI
	<b>Examiner</b>	<b>Art Unit</b>
	Dennis Ruhl	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-7 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>05042004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 1,2, are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

1. Whether the invention is within the technological arts; and
2. Whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere idea in the abstract (i.e. abstract ideas, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e. physical sciences as opposed to social sciences for example), and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, use or advance the technological arts.

In the present case, claim 1 and all claims dependent therefrom only recite an abstract idea. The recited steps of the car reservation process does not apply, involve, use, or advance the technological arts since all of the recited steps can be done with no technology at all. The examiner notes that the preamble recites, “in which it is possible to reserve a rental car through the Internet”; however, the Internet is not required in the scope of this claim and all of the steps can be performed with no technology at all.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1,2,4,7, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 1,2, there is no transitional phrase associated with claim 1, so the examiner is not clear as to where the preamble ends and the body of the claim begins, and this renders the claims indefinite. For purposes of examination, the examiner has interpreted the term "wherein" to be the equivalent of "comprising" which is an open ended transitional phrase. Correction is required.

For claim 4, the language "from a customer terminal which means a terminal of a cellular phone or communication terminal" is indefinite. Is applicant attempting to recite some kind of means plus function limitation under 35 USC 112,6<sup>th</sup> paragraph? Is applicant reciting that the customer terminal can be a cellular phone or a communication terminal? If the latter is true, the examiner suggests language such as "wherein said customer terminal is selected from the group consisting of a cellular phone and a communication terminal".

For claim 7, it is not clear if the claim is a method claim or an article claim directed to a storage medium. The preamble seems directed to a recording medium that a computer program is stored on but the language "including the steps of" is directed to a method. It is not stated that the "including the steps of" part of the claim is

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part of the program so the examiner is not clear if this is a method claim or an article claim. Correction is required.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by  
www.drivebudget.com (1998).

Drivebudget.com discloses a method of reserving a rental car by using the Internet. The car rental fixing up agent (the reservation software) directs a car rental agent (at the rental branch) to allocate a rental car on the basis of customer entered information. The customer is asked to enter a pickup location and a drop-off location for the reservation. On the pickup day the customer will go to the pickup location and will be allocated a rental vehicle by an agent. When the rental vehicle is dropped off, the agent will then be taking back the car. Claim 1 reads on the well known method of renting a rental car such as disclosed by Drivebudget.com.

7. Claims 3,4, are rejected under 35 U.S.C. 102(e) as being anticipated by Pugliese III et al. (20010016825).

Pugliese discloses a system for renting a car (see paragraph 91). Pugliese discloses a car rental control server 10 and fixing up servers (the ATM). The fixing up servers asks the control server to allocate a car according to reservation information inputted by the customer. The control server controls information relating to the reservation of cars. Pugliese discloses that telephone lines (which inherently are leased) are used for communication between the ATM and the control servers. The ATM disclosed by Pugliese is a communication terminal as is claimed in claim 4.

8. Claims 3,4,5,6,7, are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (6134534).

Walker discloses a system for taking reservations. The system has a control server for controlling rental information (provider servers 300) and a fixing up server 200 that instructs the provider servers when a reservation is made. Walker discloses the use of telephone lines (inherently are leased) for communication. With respect to the limitations defining that the system is for rental cars and that the server controls rental car information, the type of data itself is considered to be non-functional descriptive material and does not distinguish over Walker. *In re Gulack*, 217 USPQ 401 (CAFC 1983). The system of Walker is fully capable of dealing with car reservation data. The program that runs the system of Walker is inherently contained on a storage medium as is claimed in claim 7.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (6134534) in view of Pugliese III et al. (2001/0016825).

Walker discloses a method of purchasing a good or service via the Internet. The method has the customer input search criteria for the good or service desired (i.e. travel dates, times, destination location, mode of travel, etc.) and then a search is performed to identify a provider that can satisfy the inputted criteria. The good or service can be an airline reservation, a hotel reservation, cruise reservation, or other, see column 6, lines 1-16. Walker discloses that a central processing system searches multiple provider servers and if a match is found, secures a reservation for the customer. Walker does not specifically disclose that the method can be used with rental car reservations as is claimed. Pugliese discloses a reservation system for reserving airline flights and discloses that the system is also usable for hotel reservations as well as car rental reservations. The reference equates a car reservation to a hotel reservation and to an airline reservation. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method of Walker with rental car reservations as is disclosed by Pugliese so that the renting of a car can be realized with the method of Walker. It is considered inherent that when renting a car the customer

who reserved the car will show up to pick up the car, etc.. The program that runs the system of Walker is inherently contained on a storage medium as is claimed in claim 7.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hirshberg (5289369), Bishop et al. (4965821), Williams (2003/0149600), Keller et al. (2001/0053989), Kokubo et al. (6157315), DeLorme et al. (5948040), and Leiseca et al. (5253165) disclose reservation methods and systems for the rental of rental items, including rental cars.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 703-308-2262. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL  
PRIMARY EXAMINER